

REMARKS

In the Final Office Action¹ mailed December 7, 2010, the Examiner:

- 1) rejected claims 1, 2, 5, 6, 11-17, 20, 21, 23-25, 27, 45-51, and 54-59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,005,945 to Whitehouse (“Whitehouse”) in view of U.S. Patent No. 5,019,991 to Sansone (“Sansone”) and further in view of U.S. Patent No. 7,458,612 to Bennett (“Bennett”); and
- 2) rejected claims 52 and 53 under 35 U.S.C. § 103(a) as being unpatentable over *Whitehouse*, *Sansone*, and *Bennett* in view of Official Notice.

By this response, Applicants have amended claims 1, 11, 20, and 24. No new matter has been added. Claims 7, 8, 18, 19, 28, 30, 31, and 33-44 were previously withdrawn from consideration. Claims 1, 2, 5, 6, 11-17, 20, 21, 23-25, 27, and 45-59 are under current examination.

Summary of the Interview

Applicants thank the Examiner for participating in the interview conducted on February 11, 2011, initiated by Applicants’ representative. During the interview, Applicants’ representative and the Examiner discussed the *Bennett* reference and Applicants’ specification. No agreement was reached with regard to this reference.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified in this paper, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

Rejection of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the above rejections of the pending claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to the claims as amended.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 8 (July 2010)(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Amended independent claim 1 recites, among other things,

printing, using a printing device, a postage indicia that represents the estimated postage amount, an addressee information, a sender information, a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia, a unique delivery confirmation number that uniquely identifies the mailpiece, and a date,

wherein the postage indicia represents the estimated postage amount in a format readable by machine only, and

wherein at least one of the unique postage number and the unique delivery confirmation number is used to retrieve billing information of a sender that includes an account number of the sender;

...; and

paying an adjusted postage amount, subsequent to the depositing, in response to a bill generated using the billing information.

The Final Office Action correctly states that *Whitehouse* fails to disclose these elements of claim 1. O.A. at 7.

The Final Office Action alleges that *Sansone* discloses “paying an adjusted postage amount, subsequent to the depositing, in response to a bill.” This is incorrect. *Sansone* discloses that “[i]n the event that postage printed on the envelope is incorrect, . . . an appropriate adjustment is made in the descending register as to the correct amount and then a certification stamp placed upon the mail to indicate to the post office that there is no need for making an independent check to verify the actual postage.” *Sansone*, col. 6:30-40 (emphasis added). *Sansone* discloses that the descending register is part of secure housing 73 (Figure 1), and additionally indicates that “physical security is required in a system in accordance with the invention to ensure for example that the mail piece that is certified correctly corresponds to the mail piece that was read, counted, weighted, etc. For this purpose the system of Fig. 2 may be enclosed in a secure housing 73.” *Sansone*, col. 4:43-48.

Thus, *Sansone* discloses that incorrect postage is corrected before being deposited with a delivery operator or mailing system. Because the postage correction is performed within the secure housing, *Sansone* cannot disclose “paying an adjusted

postage amount subsequent to the depositing" or "in response to a bill generated using the billing information."

Bennett fails to cure this defect of *Whitehouse* and *Sansone*. The Final Office Action did not allege that *Bennett* discloses "paying an adjusted postage amount, subsequent to the depositing, in response to a bill generated using the billing information." Indeed, *Bennett* does not disclose any such billing and fails to cure this defect of *Sansone* and *Whitehouse*.

The Final Office Action alleged that *Bennett* discloses that "payment indicia 81 is embedded in the characters 28 (which the Final Office Action alleges constitutes a unique postage number)" and that this, combined with *Bennett*'s alleged disclosure that Payment segment 1 contains "one of several forms of payment indicators," constitutes "the unique postage number . . . is associated with billing information of a sender that identifies an account of the sender." Applicants respectfully disagree as this is a mischaracterization of the teachings of *Bennett*.

Bennett clearly discloses that the payment indicia 81 is a postage value. *Bennett*, Figs. 8, 9, Item 81. The postage value of *Bennett* cannot constitute the claimed billing information of a sender because the postage value of *Bennett* does not include an account of the sender. Therefore, *Bennett*'s disclosure that payment indicia 81 is embedded in the characters 28 does not constitute or suggest that "at least one of the unique postage number and the unique delivery confirmation number is used to retrieve billing information of a sender that includes an account number of the sender," as recited in amended claim 1.

Furthermore, *Bennett* discloses that “exemplary Payment segment 1 [contains] any one of several forms of payment indicators.” *Bennett*, col. 3:35-36 (emphasis added). *Bennett* discloses that one of the acceptable forms of payment is from an Express Mail Corporate Account. *Bennett*, col. 3:37-38. *Bennett* further discloses that “[t]he invention detects whether the form of payment, input by the user, is supported by the USPS. . . . In the event that the USPS does not support the user-input form of payment . . . the invention generates a Payment segment 1, formatted and positioned as a blank block.” *Bennett*, col. 3:48-56.

Rather than disclosing that the account number for an Express Mail Corporate Account is associated with the characters 28, *Bennett* discloses that the postage amount is associated with the characters 28 and the form of payment is from an Express Mail Corporate Account. Contrary to the allegation of the Final Office Action, *Bennett* fails to disclose or suggest at least “wherein at least one of the unique postage number and the unique delivery confirmation number is used to retrieve billing information of a sender that includes an account number of the sender,” as recited by amended claim 1.

The alleged Official Notice also fails to disclose at least these elements of amended claim 1. The Final Office Action cited Official Notice for allegedly disclosing the conversion of “human readable strings into formats readable by machine only such as barcodes.” O.A. at 16. Official Notice is not properly taken. In relevant part, MPEP § 2144.03 states, “[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.”

Applicants submit that the Examiner has made a generalized statement without any documentary evidence to support it. Applicants traverse the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." See, *id.* Applicants submit that "[d]eficiencies of the cited references cannot be remedied by . . . general conclusions about what is 'basic knowledge' or 'common sense.'" In re Lee, 61 USPQ2d 1430, 1432-33 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made," or else withdraw the rejection. See, MPEP § 2144.03.

Even assuming the Official Notice is properly taken, which Applicants do not concede, Official Notice fails to cure the deficiencies of *Whitehouse*, *Sansone*, and *Bennett*, discussed above. That is, Official Notice does not disclose or suggest "wherein at least one of the unique postage number and the unique delivery confirmation number is used to retrieve billing information of a sender that includes an account number of the sender" or "paying an adjusted postage amount, subsequent to the depositing, in response to a bill generated using the billing information," as recited by amended claim 1.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Final Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1 under 35 U.S.C. § 103 as being obvious from *Whitehouse* in view of *Bennett* is thus improper and should be withdrawn.

Although of different scope, independent claims 11, 20, and 24 include elements similar to those discussed above. For at least the same reasons presented above in connection with the patentability of claim 1, the Final Office Action does not establish a *prima facie* case of obviousness with respect to independent claims 11, 20, and 24. Accordingly, these claims are patentable over the cited references and, thus, are allowable. Applicants respectfully request that the Examiner withdraw the section 103 rejection of claims 11, 20, and 24.

Dependent claims 2, 5, 6, 12-17, 21, 23, 25, 27, and 45-59 are also nonobvious at least by virtue of their dependence from nonobvious independent claims, as well as by virtue of reciting additional elements not taught or suggested by the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 5, 6, 12-17, 21, 23, 25, 27, and 45-59 under 35 U.S.C. § 103(a) and issue a Notice of Allowance for all pending claims.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 18, 2011

By: _____ /Melanie Grover/
Melanie Grover
Reg. No. 63,599
(571) 203-2430